

tridecyl neopentanoate. *Id.* Therefore, the Examiner concludes that the '286 patent anticipates claims 14-37 of the present invention. *Id.* Applicants respectfully disagree and transverse this rejection for at least the following reasons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). Further, a rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (emphasis added). Notably, the reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures . . . ." *Id.*

In the present case, the Examiner failed to establish that each and every element in claims 14-37 of the present invention is either expressly or inherently described in the '286 patent. For example, the '286 patent does not expressly or inherently teach the "at least one liquid ester obtained by reacting at least one (C<sub>4</sub>-C<sub>6</sub>) carboxylic acid with at least one (C<sub>12</sub>-C<sub>26</sub>) alcohol" as recited in, for example, Claim 14 of the present invention. (Emphasis added). Instead, the '286 patent merely teaches that its composition "may additionally contain . . . an oily conditioning agent which is an organic, nonvolatile oil." Col. 14, lines 28-31 (emphasis added). Further, the '286 patent teaches that "[t]he oil may comprise esters of the formula RCO-OR' wherein R and R' are each independently a C<sub>1-25</sub> . . . chain[.]" Col. 14, lines 37-40 (emphasis added). Therefore, the oily conditioning agent taught in the '286 patent, let alone the esters, is not a requisite

component, but merely an optional component, and picking and choosing would be necessary to include any oily conditioning agent in the composition of the '286 patent.

Moreover, there is no guidance provided in the '286 patent that would have led to the selection of an ester that falls within the scope of those recited, for example, in independent claim 14 of the present invention from among all the oily conditioning agents disclosed at col. 14, lines 37 through col. 15, line 54 of the '286 patent. In fact, while "isostearyl neopentanoate" and "tridecyl neopentanoate" are among the numerous esters disclosed in the '286 patent, they are merely two esters in a laundry list of conditioning agents that includes many other esters, such as those disclosed on pages 24-26 of the *C.T.F.A. Cosmetics Ingredient Handbook*, First Edition, 1988, as well as other suitable oils. No guidance is given in the '286 patent that would have led to the selection of either of these two esters over any of the other oily conditioning agents disclosed in the reference.

Thus, in an attempt to arrive at the presently claimed invention, one of ordinary skill in the art would be required to:

- 1) select to include the optional oily conditioning agent into the composition of the '286 patent;
- 2) then select an ester from among the numerous oily conditioning agents disclosed at col. 14, lines 37 through col. 15, line 54 of the '286 patent; and
- 3) then select either of the two esters pointed to by the Examiner from among all the other esters disclosed in the '286 patent.

The '286 patent simply fails to provide the guidance for making these numerous selections. Importantly, it must also be emphasized that a proper § 102 rejection must not involved "picking, choosing, and combining various disclosures" of a reference. *In*

*re Arkley*, 455 F.2d at 587,172 U.S.P.Q. at 526. Because of the many selections that were made in the § 102(e) rejection contained in the Office Action, Applicants respectfully submit that the rejection is improper. Accordingly, Applicants respectfully request this rejection be withdrawn.

### III. Conclusion

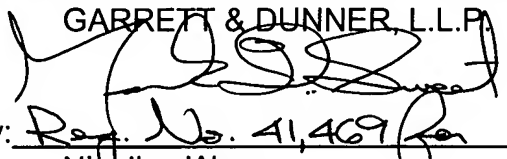
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, and the timely allowance of the rejected claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is invited to call the undersigned Applicants' representative at (202) 408-4218.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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